

<b>PRE-APPEAL BRIEF REQUEST FOR REVIEW</b>		Docket Number (Optional)  STL03262	
I hereby certify that this correspondence is being deposited with the <del>United States Postal Service with sufficient postage as first class mail</del> in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)] on <u>March 24, 2009</u> Signature <u>/Mitchell K. McCarthy/</u> Typed or printed name <u>Mitchell K. McCarthy</u>		Application Number <u>10/692,516</u> First Named Inventor <u>SonSeng Yeow</u> Art Unit <u>3687</u>	Filed <u>October 24, 2003</u> Examiner <u>Frenel, Vanel</u>
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s).            Note: No more than five (5) pages may be provided.</p>			
I am the <input type="checkbox"/> applicant/inventor. <input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/06) <input checked="" type="checkbox"/> attorney or agent of record. Registration number <u>38,794</u> <input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____		<u>/Mitchell K. McCarthy/</u> Signature <u>Mitchell K. McCarthy</u> Typed or printed name <u>(877) 654-6652</u> Telephone number _____ Date	
NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.			
<input type="checkbox"/> *Total of <u>1</u> forms are submitted.			

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: **SonSeng Yeow and ChinLin Tan**

Assignee: SEAGATE TECHNOLOGY LLC

Application No.: 10/692,516

Group Art Unit: 3687

Filed: **October 24, 2003**

Examiner: **Vanel Frenel**

For: **SYSTEM AND METHOD FOR INVENTORY REPLENISHMENT**

**Mail Stop AF**

**Commissioner for Patents**

**P.O. Box 1450**

**Alexandria, VA 22313-1450**

COMMENTS IN SUPPORT OF PRE-BRIEF REQUEST FOR REVIEW

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THE OFFICE'S RATIONALE FOR MAINTAINING THE SECTION 101 REJECTION OF CLAIM 15 LEAVES UNRESOLVED FACTUAL AND LEGAL ISSUES THAT JUSTIFY THE REQUESTED WITHDRAWAL OF THE FINAL REJECTION

In the final rejection the Office correctly stated the machine-or-transformation requirement of Section 101.<sup>1</sup> There, the Office alleged that claim 15 fails to positively recite the subject matter that is transformed.<sup>2</sup> Applicant rebutted that allegation by specifically showing that claim 15 positively recites the signal being transformed in terms of the language *displaying a signal...subsequently modifying the signal*.<sup>3</sup> Applicant bolstered its rebuttal evidence with a detailed showing that the recited signal transformation is statutory subject matter according to *Bilski* because the transformed signal is featured as being visually depicted and the visual depiction represents a physical object.<sup>4</sup>

The Office's rationale for maintaining the Section 101 rejection is the following: "the term "continuously displaying a signal" does not make it statutory." The Panel will appreciate that, contrary to the Office's stated rationale, Applicant in fact did not posit that "continuously displaying a signal" renders statutory subject matter in claim 15. Rather,

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<sup>1</sup> Office Action of 12/24/2008 pg. 2.

<sup>2</sup> *Id.*, para. 3 lines 12-14.

<sup>3</sup> Applicant's Response of 2/24/2009 pg. 9: last two lines to pg. 10: first line.

<sup>4</sup> *Id.*, ppg. 7-10.

Applicant's rebuttal clearly stated that *displaying a signal...subsequently modifying the signal* meets the transformation requirement of Section 101, in view of *Bilski*. The Office is obligated to respond substantively to Applicant's rebuttal evidence. However, here the Office's stated rationale in the Advisory Action is nonresponsive to Applicant's rebuttal evidence. That leaves an unresolved factual issue that must be addressed before it can be said that a bona fide issue that is ripe for appeal has arisen with respect to the Section 101 rejection of claim 15.

The Office's rationale for maintaining the Section 101 rejection is also in error because it reverts from the correct machine-or-transformation requirement to an erroneous machine requirement.<sup>5</sup> The Panel will appreciate that, contrary to the Office's stated rationale, there is no Section 101 requirement that claim 15 recite language that is "tied to another statutory class (such as a particular apparatus)"<sup>6</sup> where the claim otherwise meets the transformation requirement. The Office's stated rationale leaves an unresolved legal issue that must be addressed before it can be said that a bona fide issue that is ripe for appeal has arisen with respect to the Section 101 rejection of claim 15.

Therefore, Applicant respectfully requests that the Panel withdraw the final rejection of claim 15 and the claims depending therefrom for further prosecution on the merits so that these unresolved issues can be properly addressed.

THE OFFICE'S RATIONALE FOR MAINTAINING THE SECTION 103 REJECTION  
OF CLAIMS 8 AND 15 LEAVES UNRESOLVED FACTUAL ISSUES THAT JUSTIFY  
THE REQUESTED WITHDRAWAL OF THE FINAL REJECTION

In maintaining the Section 103 rejection the Office takes the incredulous position of responding to an argument that the Applicant in fact clearly did not make: "Applicant argues that...(ii) The cited references fail to suggest the features of the rejected claims...."<sup>7</sup> In its After-Final Response Applicant clearly rebutted that straw-man argument by the Office in the final rejection.<sup>8</sup> There, Applicant showed that *KSR* left untouched the requirement that a teaching or suggestion for each claim limitation must be shown in the

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<sup>5</sup> Advisory Action, pg. 2:7-8.

<sup>6</sup> *Id.*

<sup>7</sup> *Id.*, pg. 2:2-3.

<sup>8</sup> Applicant's Response of 2/24/2009 pg. 10.

prior art in order to substantiate a *prima facie* case of obviousness.<sup>9</sup> Applicant did not state or imply that the prior art is somehow limited to the cited references. Applicant further correctly pointed out that where the cited references fail to teach or suggest a feature of the rejected claims, the Office is obligated to bridge that gap in the teachings of the cited references by articulating an objective reason as to why the skilled artisan would find the differences between the claimed subject matter and what the cited references teach to be obvious.

Independent claims 8 and 15 recite in pertinent part *modify the signal...to continuously display a second visual characteristic different than the first visual characteristic responsive to the supplier sending the requested replenishment of inventory and during the time that the requested replenishment of inventory is in transit to the user.*

In the final rejection the Office explicitly stated that Li does not disclose the *second visual characteristic*.<sup>10</sup> In the final rejection the Office relied on Hill paragraphs 0043-0045 to cure the deficiency of Li in that regard. However, in maintaining the final rejection the Office takes the position that it previously relied on Li paragraphs 0032-0033 as disclosing the *second visual characteristic*. Applicant requested clarification of this discrepancy between what is actually in the record and what the Office represents the record to be, via a telephone call to Mr. Frenel; no clarification was provided. In fact, Li paragraphs 0032-0033 describe the embodiments of FIGS. 1A and 1C. There is nothing in that passage or anywhere else in Li that would suggest to the skilled artisan that Li teaches or suggests the *second visual characteristic* as featured by claims 8 and 15. The Office's position that the cited references teach or suggest the featured *second visual characteristic* is a mischaracterization of what those references actually do teach. That leaves an unresolved factual issue that must be addressed before it can be said that a bona fide issue that is ripe for appeal has arisen with respect to the Section 103 rejection of claims 8 and 15.

In sum, the totality of evidence from the Office in support of *prima facie* obviousness of the featured *second visual characteristic* is a mere broad pointing, without explaining the particulars, to paragraphs 0043-0045 of Hill in the final rejection and to

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<sup>9</sup> *In re Royka*, 180 USPQ 580 (CCPA 1974); *In re Ochial*, 71 F.3d 1565, 1572 (Fed. Cir. 1995); *In re Wilson*, 165 USPQ 494, 496 (CCPA 1970); MPEP 2143.03; MPEP 2141.

<sup>10</sup> Office Action of 12/24/2009 pg. 3 para. 5:8-14: "Li does not explicitly disclose...to subsequently modify the signal...to continuously display a second visual characteristic...."

paragraphs 0032-0033 of Li in the Advisory Action. The Office attempts to characterize the weight of that evidence as sufficient: “the Examiner respectfully submits that he has at least satisfied the burden of presenting a prima facie case of obviousness, since he has presented evidence of corresponding claim elements in the prior art and has expressly articulated the combinations and the motivations for combinations that fairly suggest Applicant’s claimed invention.”<sup>11</sup> The Panel will appreciate the error of this statement by the lack of any evidence in the record showing with particularity how the prior art teaches the *second visual characteristic* as featured by claims 8 and 15.

The Office goes on to allege that Applicant has failed to show evidence that distinguishes the rejected claims from the cited references: “Applicant has failed to specifically point out how the language of the claims patentably distinguishes them from the applied references.”<sup>12</sup> The Panel will appreciate the error of this statement because it completely ignores the fact that Applicant has shown with particularity how the claimed subject matter is patentably distinguishable over the cited references.<sup>13</sup> Applicant will now summarize that evidence that is already in the record.

Applicant has shown that the *second visual characteristic* in claims 8 and 15 defines the interval after the requested replenishment of inventory has been sent out of the supplier inventory but before the requested replenishment of inventory has been received into the user inventory; that is, while the *requested replenishment of inventory* is in transit from the supplier inventory to the user inventory. In other words, the *second visual characteristic* display is associated with the physical location of the *requested replenishment of inventory* being neither in the supplier inventory nor in the user inventory.

Applicant has shown that the only reference to “location” in the passage of Hill relied on by the Office (and elsewhere) is the location of the sensor.<sup>14</sup> The location of the sensor is only relevant to the location of the requested replenishment inventory while it remains in the supplier inventory. The location of the sensor is irrelevant to the location of the requested replenishment inventory during transit from the supplier inventory to the user inventory as featured by the rejected claim. There is nothing in the Office’s revisionist

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<sup>11</sup> Advisory Action pg. 2:12-14 (emphasis added).

<sup>12</sup> Id. pg. 2:19-20.

<sup>13</sup> Applicant’s Response of 2/24/2009 ppg. 12-16.

<sup>14</sup> Hill para. [0043]:11-12.

reliance on Li in the Advisory Action that teaches a visual characteristic being associated with the location of requested replenishment of inventory.

Applicant also showed the SuppliLink<sup>15</sup> referred to by Hill is evidence that it does not teach the featured *second visual characteristic*. For example, Applicant showed that the SuppliLink display indicates which items are at or below the replenishment level in the user's inventory. The display changes when the requested replenishment inventory is received by the user, not during transit as claimed. Applicant also showed that the SuppliLink color-coded display scheme depicts one of four states in the user's inventory: (1) part status is "OK" (white); (2) part status is "Replenish" (yellow); (3) part status is "Critical" (red); or part status is "Exceeds Max" (blue). Applicant thereby showed conclusive evidence that none of the SuppliLink visual indicators are associated with the location of requested replenishment of inventory at a time when it has left the supplier's inventory and is still in transit, and thus not yet in the user's inventory.

Thus, the Panel will appreciate that the Office's position that it has allegedly shown evidence that the prior art teaches all the features of claims 8 and 15 is in error. The Panel will also appreciate that the Office's position that the Applicant has allegedly failed to show evidence that the claimed subject matter is distinguishable over the cited references is in error. That leaves unresolved factual issues that must be addressed before it can be said that a bona fide issue that is ripe for appeal has arisen with respect to the Section 103 rejection of claims 8 and 15.

Therefore, Applicant respectfully requests that the Panel withdraw the final rejection of claims 1 and 8 and the claims depending therefrom for further prosecution on the merits so that these unresolved issues can be properly addressed.

Respectfully submitted,

/Mitchell K. McCarthy/

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<sup>15</sup> Hill para. [0045]:26-29; at [www.visibleinventory.com](http://www.visibleinventory.com)